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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,832	01/16/2004	William Robert Mass	279.B36US1	7138
21186 7590 05/27/2008 SCHWEGMAN, LUNDBERG & WOESSNER, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402				
EXAMINER				
MANUEL, GEORGE C				
ART UNIT		PAPER NUMBER		
3762				
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05/27/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/758,832

Applicant(s)

MASS ET AL.

Examiner

George Manuel

Art Unit

3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

Claims 1-7 and 9-30 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility.

Controllers 160, 260, and 360 lack specific and substantial elements. The specification states the switches 162, 262, and 362 are controlled by their respective controllers 160, 260, and 360; however, the specification lacks specific circuitry elements to enable one of ordinary skill in the art to construct the controllers to enable the function of controlling. FIGS. 3-5 merely show blocks labeled "controller" without elements shown to provide for activation of the disclosed switches. It doesn't appear obvious to one having ordinary skill in the art how the controllers could be made to perform their function of controlling their switches without undue experimentation.

Claim Rejections - 35 USC § 112

Claims 1-7 and 9-30 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3762

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1, 2 and 18 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Von Arx et al (US 6,993,393).

Von Arx et al disclose both the implantable device 100 and the external device 200 are battery powered. Coil 150B is configured to transmit and receive data to and from telemetry coil 150A.

Claims 12, 15 and 18 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Itoga et al (US 5,122,729).

Itoga et al disclose a first battery comprising battery 9, a controller comprising an AC/DC conversion circuit 8. Circuit 8 is shown to be in parallel with the battery 9. The examiner is interpreting the detection coil 12 to be capable of detecting "data" from the secondary coil 7 comprising changes in induced voltage resulting from changes in distance between the primary coil 3 and the secondary coil 7.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4, 11, 16, 22, 23, 24, 25, 26, 27, 28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itoga et al (US 5,122,729).

Itoga et al show all of the claimed features except for an implanted device or a switch.

One of ordinary skill in the art would have found it obvious to use the teaching of Itoga et al with an implanted device because the inductive coupling does not require a "hard wired" circuitry and because it is well known to use telemetric devices with implanted devices to avoid the need to pass wires through the skin.

Regarding the feature of a switch, one of ordinary skill in the art would have found it obvious to provide a switch to the battery 9 to control current through the coil 7 because the coil 7 when powered provides a signal that is detectable and when it is desirable not to detect the coil current, a switch is a common component to insert to interrupt current flow.

Response to Arguments

Applicant's arguments filed 1/31/08 have been fully considered but they are not persuasive. The remarks are directed toward the operation of the switches and what the controller does and not how the controller performs the activating function for a particular switch. Neither the disclosure, nor the arguments clearly define what enables the controller to control the switches. The statements directed toward the functional effect of the controller do not clearly show one of ordinary skill in the art how to build the

controller or what elements to include in the controller to achieve the controllability for the system.

Being simple and compatible with many known controllers and implantable devices does not explain the circuitry elements that enable one of ordinary skill in the art to construct the controllers to enable the function of controlling. In addition, merely stating the purpose of a controller and switch does provide sufficient specifics to enable one of ordinary skill in the art to construct the circuitry.

Applicant's argument that sensing or detecting a voltage as disclosed in Itoga is not "communicating data with inductive telemetry" is without merit. Itoga teaches the detection coil 12 detects and outputs as a change in the induction voltage any load fluctuation resulting from a change in the distance between the primary coil 3 and the secondary coil 7. This change in induction is clearly a fact or piece of information and the value is derived from a type of scientific experiment, thus rendering the change as data. Further, the data is given from coil 7 to coil 3 based on their separated distance. If the distance is too great, the information indicates coil 3 needs to be placed closer to coil 7. Fluctuations in coil 7 voltage are also measured. See col. 2, lines 25-35.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Manuel whose telephone number is (571) 272-4952.

